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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,086	03/20/2004	Joe Chen	MTKR001	1691

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EXAMINER

NGUYEN, TANH Q

ART UNIT PAPER NUMBER

2182

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,086

Applicant(s)

CHEN, JOE

Examiner

Tanh Q. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2004.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.  
4a) Of the above claim(s) 19-40 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 20 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 03/20/04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-18, drawn to system reconfiguration (redefining registers of task files), classified in class 713, subclass 100.
  - II. Claims 19-40, drawn to I/O access regulation (entering information into a flash ROM directly by the host through a flash controller), classified in class 710, subclass 36.
2. Newly submitted claims 19-40 are directed to invention II, that is independent or distinct from the invention originally claimed for the following reasons: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as entering information into a flash ROM directly by the host through a flash controller - without having to redefine registers of task files. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Oath/Declaration***

5. The reissue oath/declaration filed with this application is defective because it fails to adequately identify at least one error, which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

#### **§ 1.175 Reissue oath or declaration.**

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, **stating at least one error being relied upon as the basis for reissue**

#### **MPEP 1414 - II (B)**

In identifying the error, it is sufficient that the reissue oath/declaration identify a single word, phrase, or expression in the specification or in an original claim, and **how it renders the original patent wholly or partly inoperative or invalid.**

Stating the error to be that "claim 1 defines the subject invention too narrowly in that it recites unnecessary step(s) regarding IDE bus activities" is not sufficient to identify the error since there is no explanation to clearly indicate which steps are unnecessary, and how the unnecessary steps would render the original patent to be wholly or partially inoperative or invalid.

Furthermore, per **MPEP 1414 - II (C)**

the oath /declaration must **specifically** identify an error. In addition, **it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error.** See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). **Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.**

6. Claims 1-18 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

#### ***Allowable Subject Matter***

7. The following is a statement of reasons for the indication of allowable subject matter:

The prior art, individually or in combination, does not teach a method suitable for a Host to update the firmware of a flash ROM through an IDE interface comprising reinterpreting all IDE bus activities so that the flash ROM is updated without using definitions of the IDE interface, redefining registers of task files from definitions of the IDE interface to definitions for updating the flash ROM, entering a flash ROM programming mode with the registers of the task files working under the definitions for

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updating the flash ROM, and reading or writing data on the flash ROM by the Host using the redefined task files of the IDE interface through a software cycle or a hardware cycle.

The prior art, individually or in combination, does not teach a system communicating with a Host, wherein when the flash ROM is to be updated, the Host redefines registers of the task files so that a plurality of control commands and the data are transferred between the system and the Host through the IDE interface, and so that original definitions of the IDE interface is changed and re-defined according to the re-defined registers of the task files; when the Host requests to access the flash ROM, the Host switches the system into a flash ROM programming mode under the re-defined IDE interface and the re-defined registers of the task files, and the flash controller receives read/write activities to the redefined task files from the Host and interprets these redefined activities to perform writing or reading the data on the flash ROM through a software cycle or a hardware cycle.

8. Original claims 1-18 would be allowable if the rejections under 35 U.S.C. 251 are overcome. If the original claims are found allowable, and a divisional application is filed for the non-elected claims, further action in the application will be suspended, pending resolution of the divisional application.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Thanh Quang Nguyen whose telephone number is (571) 272-4154 and whose e-mail address is [tanh.nguyen36@uspto.gov](mailto:tanh.nguyen36@uspto.gov). The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (571) 272-2100. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 for After Final, Official, and Customer Services, or (571) 273-4154 for Draft to the Examiner (please label "PROPOSED" or "DRAFT").

Effective May 1, 2003 are new mailing address is:

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Effective December 1, 2003, hand-carried patent application related incoming correspondences will be to a centralized location.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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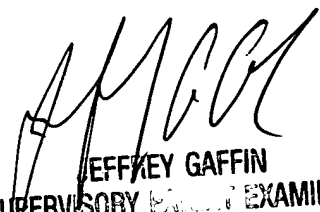
published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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Business Center (EBC) at 866-217-9197.



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TQN

April 28, 2005